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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/317,069	05/13/1999	SHIGETAKA TANAKA	2271/59262	8608

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NEW YORK, NY 10038

EXAMINER

POKRZYWA, JOSEPH R

ART UNIT PAPER NUMBER

2622

DATE MAILED: 04/27/2004

20

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/317,069

Applicant(s)

TANAKA, SHIGETAKA

Examiner

Joseph R. Pokrzywa

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The amendment raises new issues in claims 4 and 11.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: of the reasons discussed in the attached action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Period for Reply*

1. The period for reply continues to run 3 MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 or a request for a continued examination (RCE) in compliance with 37 CFR 1.114 must be timely filed to avoid abandonment of this application.

### *Response to Amendment*

2. The amendment filed 4/12/04 under 37 CFR 1.116 to independent **claims 4 and 11** in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

- a. The proposed amendment raises new issues that would require further consideration and/or search.

Regarding currently amended **claims 4 and 11**, the addition of the limitation requiring “canceling performance of the facsimile communications operation using said optional frame when said [identification information] telephone number of the calling facsimile machine does not correspond with the identification information prestored in said memory”, raises new issues

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requiring further search and consideration, as the identification information and the telephone number have a different scope.

***Response to Arguments***

3. Applicant's arguments filed 4/12/04 regarding **claims 1, 4-7, 10, and 11** have been fully considered but they are not persuasive.

4. In response to applicant's arguments regarding the rejection of **claim 1**, cited in the Office action dated 1/23/04, as being anticipated by Imai *et al.* (U.S. Patent Number 6,104,504), whereby applicant argues on pages 8-10 that Imai fails to teach of performing **at the called station** a number of steps including comparing **the identification information of the calling facsimile machine** with the identification information prestored in the memory, canceling performance of the facsimile communications operation using the optical frame when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory, and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory.

The examiner believes that the focal point of applicant's arguments are based on the interpretation of the phrase "identification information of a calling station". Currently, claim 1 recites "receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of said calling facsimile machine; comparing said identification information of said calling facsimile machine with the identification information prestored in said memory; canceling performance of the facsimile

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communications operation using the optional frame when said identification information of said calling facsimile machine does not correspond with the identification information prestored in said memory". The examiner interprets the phrase "identification information of the calling facsimile machine" as the document sheet numbers set in the SEP signal that are received from a calling facsimile machine, as read in column 5, lines 19 through 40, wherein Imai states that "the received SEP signal is analyzed, [and] the document sheet number set in the calling receiving station is read". Because the document sheet numbers are identification information received from a calling facsimile machine, the sheet numbers can be considered as "identification information of a calling facsimile machine".

Further, as read in column 6, lines 43 through 56, the recipient of the document calls the apparatus to inform the apparatus to transmit the document using the SEP signal, and as read in column 8, lines 32 through 59, the telephone number of the destination is set in the document sheet number. Thus, one of ordinary skill in the art can further recognize that the document sheet number can be the telephone number of the calling facsimile apparatus, which is also the destination apparatus. Therefore, as seen in Fig. 6, Imai teaches of comparing said identification information of said calling facsimile machine (the document sheet number in the SEP) with the identification information prestored in said memory (document sheet numbers stored in the queue, seen in step S110, column 5, lines 31 through 40); canceling performance of the facsimile communications operation using the optional frame when said identification information of said calling facsimile machine does not correspond with the identification information prestored in said memory (being "no" in step S110, column 5, lines 31 through 40).

While the structure of the system taught by Imai is different than that described in the current application, the language of the current claims does not distinguish this difference. Notably, as understood by the examiner, the current invention describes a communication operation between a calling facsimile device and a called facsimile device, while Imai teaches of a communication between an apparatus that stores documents which can be requested to be transmitted to a recipient. However, as the claims are currently worded, the communication operation can be interpreted to one of ordinary skill in the art as the polling transmission seen in step S111 of Fig. 6 of Imai. Therefore, the rejection of **claim 1**, as well as **claims 3-11**, which were cited under 35 U.S.C. 102(e), as being anticipated by Imai *et al.*, are maintained.

Continuing, in response to applicant's arguments regarding the rejection of **claim 2**, cited in the Office action dated 1/23/04 as being unpatentable over Imai *et al.* in view of Yoshida (U.S. Patent Number 5,671,270), whereby on pages 11-13 applicant argues that Yoshida fails to cure the deficiencies of Imai. As discussed above, Imai can be interpreted as teaching all of the limitations required in claim 1. The examiner notes that the reference of Yoshida is used to teach a feature taught in dependent claim 2 that Imai fails to specifically teach. Particularly, Imai does not expressly disclose if the identification information prestored in the memory comprises subscriber identifications **each contained in a frame TSI** to be generated by each of the plurality of different facsimile machines and the identification information received in the receiving step is a **subscriber identification contained in a frame TSI** generated by the calling facsimile machine.

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Yoshida discloses a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (column 6, line 50 through column 7, line 25, and column 11, lines 6 through column 12, line 64, being passwords that are registered that correspond to a PWD signal in a polling request), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 11, line 39 through column 12, line 21, wherein a polling receive request is received, which includes a SEP signal and a PWD signal, with the password in the PWD signal being identifying information). Further, Yoshida teaches that the identification information prestored in the memory comprises subscriber identifications each contained in a frame TSI to be generated by each of the plurality of different facsimile machines (column 6, line 50 through column 7, line 25, and column 9, lines 40 through 48) and the identification information received in the receiving step is a subscriber identification contained in a frame TSI generated by the calling facsimile machine (column 6, line 50 through column 7, line 25, and column 9, lines 40 through 48). Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Yoshida's teachings in the system of Imai. Therefore, the rejection of dependent **claim 2**, as cited under 35 U.S.C. 103(a), as being unpatentable over Imai *et al.* in view of Yoshida, is maintained.

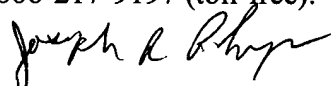
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***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

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